

REMARKS

Withdrawal of the restriction requirement is respectfully requested. Applicants traverse the restriction requirement because the restriction requirement does not meet the requirements of 35 U.S.C. §121 and search and examination of the entire application would not be a serious burden on the Examiner.

The Examiner has identified four sets of claims, as listed below:

Group 1: Claims 1-8, directed towards a semiconductor wafer

Group 2: Claims 9-15, directed towards a method for making semiconductor wafer

Group 3: Claims 16-24, directed towards an apparatus for identifying a semiconductor wafer

Group 4: Claims 25-30, directed towards using an apparatus for identifying a semiconductor wafer

Applicants respectfully submit that the claims of Groups 1 and 2 are not independent and distinct from each other. Similarly, the claims of Groups 3 and 4 should not be grouped separately from each other because they are not independent and distinct. Therefore the following grouping of claims would be more proper:

Group A: Claims 1-15, directed towards a semiconductor wafer and method for making therefor

Group B: Claims 16-30, directed towards and apparatus for identifying a semiconductor wafer and method of using therefor

The reasons as to why Groups 3 and 4 are not independent and distinct from each other is moot, because even if the Examiner grouped the claims as suggested by the Applicants, the Applicants would elect Group A (claims 1-15). Therefore, only support for the reasons why Group 1 and 2 are not independent and distinct will be addressed herein.

The Examiner states that Groups 1 and 2 are distinct from each other because the product as claimed (Group 1) can be made by a materially different process than that claimed

in Group 2. More specifically, the Examiner states, "the magnetic region could be formed by solid source rather than implanting, sputtering, or magnetic film." As a first point, independent claim 9 states "providing the at least one region with magnetic means." The process used to provide magnetic means is not limited to the processes listed in dependent claims 10, 11, or 12 (sputtering, ion implantation, or depositing a magnetic film on at least on surface of the semiconductor wafer, respectively). Independent claim 9 is not limited to the process used to provide magnetic means. Therefore, the example that the Examiner provided (using a solid source) is covered by independent claim 9. Therefore, the Examiner has failed to show how the product as claimed in Group 1 can be made by a materially different process than that claimed in Group 2.

target  
is  
not  
solid  
source

Secondly, it is unclear as to how the Examiner's example of a "solid source" differs from the processes listed (and claimed in dependent claims only), such as sputtering. Sputtering uses a target (i.e. solid source) that projects ions (i.e. solid sources) onto a substrate. Therefore, the Examiner has incorrectly listed processes that use a solid source and stated that a process using a solid source is different than the listed processes. Since the Examiner's example of a different process is, in fact, not a different process than those listed and claimed in dependent claims, the Examiner has failed to show how the product as claimed can be made by a materially different process adequate support.

The Examiner has also failed to show how the process as claimed can be used to make a materially different product. Therefore, the claims of Group 1 and 2 are not distinct as asserted by the Examiner. Hence, the Applicants request that the Examiner organize the claims of Groups 1 and 2 into one group.

In addition, the search and examination of all claims would not be a serious burden on the Examiner. A search of the method claims would involve searching for semiconductor wafers having magnetic means, which are included in the structure claims. The Examiner will inherently search the subject matter included within the structure claims when he or she searches the method claims. Accordingly, examination of the claims of Groups 1 and 2 is not a serious search burden on the Examiner. Therefore, the Examiner must examine the entire application on the merits even if it includes claims to independent and distinct inventions (which Applicants submit is not true in regards to Groups 1 and 2). M.P.E.P. § 803.

If the restriction requirement is not withdrawn, Applicants elect to prosecute the invention of claims 1-8 (Group 1). However, if the Examiner regroups the claims as suggested by the Applicants, Applicants elect claims 1-15 (Group A). Please contact the Applicants' practitioner below if there are any issues regarding this communication or the current Application.

Respectfully submitted,

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